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EXAMINER

YOUNG, JOHN L

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/498,515

Applicant(s)
Page et al.,

Examiner
John Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 14, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-18, 20-23, and 25-27 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-18, 20-23, and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Handwritten signature and date: 12-8-2003

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FIRST ACTION REJECTION (ON RCE)

(PAPER #12)

REQUEST FOR CONTINUED EXAMINATION (RCE)

1. The request for continued examination (RCE) filed on 08/14/2003, paper#11, under 37 CFR 1.114 based on parent Application No. 09/498,515 is acceptable and an RCE has been established. An action on the RCE follows:

STATUS

2. Claims 1-8, 10-18, 20-23 & 25-27 are pending.

DRAWINGS

3. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM OBJECTION—MPEP 608.01(m)

4. **Objection Withdrawn.**

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CLAIM REJECTION — 35 U.S.C. §103(a)

5. Rejections Maintained.

CLAIM REJECTIONS — 35 U.S.C. §103(a)

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Independent claims 1, 12 & 22 and dependent claims 2-8, 10-11, 13-18, 20-21, 23 & 25-27 are rejected under 35 U.S.C. §103(a) as being obvious over Merriman 5,948,061 (Sep. 07, 1999) (herein referred to as (“Merriman”) in view of Srinivasan 6,357,042 (Mar. 12, 2002) [US f/d: 01/22/1999] (herein referred to as “Srinivasan”) and further in view of Rangan 6,006,265 (Dec. 21, 1999) [US f/d: 04/02/1998] (herein referred to as “Rangan”).

As per independent claim 1, Merriman (The ABSTRACT; col. 1, ll. 5-22; col. 1, ll. 28-45; col. 2, ll. 5-45; col. 3, ll. 4-67; col. 4, ll. 1-45; col. 5, ll. 63-67; and col. 6, ll. 1-12) shows most elements and limitations of claim 1.

Merriman lacks an explicit recitation of: “inserting the selected video advertising into the video stream that transfers the selected video content to the target viewer.”

Srinivasan (col. 29, ll. 16-36; col. 30, ll. 40-54; col. 33, ll. 3-20; col. 37, ll. 58-67; col. 38, ll. 1-25; the ABSTRACT; FIG. 11; FIG. 13; FIG. 14; FIG. 15; FIG. 16; FIG. 17; FIG. 18; col. 5, ll. 40-45; and col. 13, ll. 15-40) shows elements that suggest “inserting the

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selected video advertising into the video stream that transfers the selected video content to the target viewer.”

Srinivasan proposes video advertising insertion modifications that would have applied to the method of Merriman. It would have been obvious at the time of the invention to a person of ordinary skill in the art to combine the teachings of Srinivasan with the disclosure of Merriman because such combination would have provided “*targeting of advertising over networks such as the Internet. . . . [and] gather information about recipients of the advertisement. . . .*” (see Merriman (col. 1, ll. 63-67; and col. 1, ll. 1-4)) and because such combination would also have provided means for “*enhancing the main video stream. . . .*” (see Srinivasan (col. 3, ll. 40-50)).

Merriman lacks an explicit recitation of: “selecting video advertising that has a subject matter relation to the selected video content requested by the target viewer. . . .” and “disabling fast-forward capability when the selected video advertising is displayed.”

Rangan (FIG. 3b; FIG. 9; FIG. 11; col. 7, ll. 28-40; col. 13, ll. 4-15; col. 22, ll. 13-47; and col. 26, ll. 26, ll. 60) shows elements that suggest “selecting video advertising that has a subject matter relation to the selected video content requested by the target viewer. . . .” and “disabling fast-forward capability when the selected video advertising is displayed.”

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Rangan proposes advertising “subject matter relation” and “disabling fast-forward capability” modifications that would have applied to the method of Merriman. It would have been obvious at the time of the invention to a person of ordinary skill in the art to combine the teachings of Rangan with the disclosure of Merriman because such combination would have provided “*targeting of advertising over networks such as the Internet. . . . [and] gather information about recipients of the advertisement. . . .*” (see Merriman (col. 1, ll. 63-67; and col. 1, ll. 1-4)) and because such combination would also have provided means for “*Streaming digital hypervideo including copious embedded hyperlinks is distributed upon a digital communications network from a hypervideo server, normally an Internet Service provider, to multitudinous client subscribers/users/viewers (client SUVs). . . .*” (see Rangan (the ABSTRACT)).

As per claim 2, Merriman in view of Srinivasan and Rangan shows the method of claim 1. (See the rejection of claim 1 supra).

Merriman lacks an explicit recitation of the elements and limitations of claim 2.

Srinivasan (col. 29, ll. 16-36; col. 30, ll. 40-54; col. 33, ll. 3-20; col. 37, ll. 58-67; col. 38, ll. 1-25; the ABSTRACT; FIG. 11; FIG. 13; FIG. 14; FIG. 15; FIG. 16; FIG. 17; FIG. 18; col. 5, ll. 40-45; and col. 13, ll. 15-40) shows elements that suggest the elements and limitations of claim 2.

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Srinivasan proposes video advertising insertion modifications that would have applied to the method of Merriman. It would have been obvious at the time of the invention to a person of ordinary skill in the art to combine the teachings of Srinivasan with the disclosure of Merriman because such combination would have provided “targeting of advertising over networks such as the Internet. . . . [and] gather information about recipients of the advertisement. . . .” (see Merriman (col. 1, ll. 63-67; and col. 1, ll. 1-4)) and because such combination would also have provided means for “enhancing the main video stream. . . .” (see Srinivasan (col. 3, ll. 40-50)) and because such combination would also have provided means for “Streaming digital hypervideo including copious embedded hyperlinks is distributed upon a digital communications network form a hypervideo server, normally an Internet Service provider, to multitudinous client subscribers/users/viewers (client SUVs). . . .” (see Rangan (the ABSTRACT)).

As per claim 3, Merriman in view of Srinivasan and Rangan shows the method of claim 1. (See the rejection of claim 1 supra).

Merriman lacks an explicit recitation of the elements and limitations of claim 3.

Srinivasan (col. 35, ll. 48-60; col. 35, ll. 7-20; col. 35, ll. 65-67; col. 36, ll. 1-25; col. 37, ll. 40-67; col. 38, ll. 1-25; col. 29, ll. 16-36; col. 30, ll. 40-54; col. 33, ll. 3-20; col. 37, ll. 58-67; col. 38, ll. 1-25; the ABSTRACT; FIG. 11; FIG. 13; FIG. 14; FIG. 15; FIG.

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16; FIG. 17; FIG. 18; col. 5, ll. 40-45; and col. 13, ll. 15-40) shows elements that suggest the elements and limitations of claim 3.

Srinivasan proposes transport bandwidth modifications that would have applied to the method of Merriman. It would have been obvious at the time of the invention to a person of ordinary skill in the art to combine the teachings of Srinivasan with the disclosure of Merriman because such combination would have provided “*targeting of advertising over networks such as the Internet. . . . [and] gather information about recipients of the advertisement. . . .*” (see Merriman (col. 1, ll. 63-67; and col. 1, ll. 1-4)) and because such combination would also have provided means for “*enhancing the main video stream. . . .*” (see Srinivasan (col. 3, ll. 40-50)) and because such combination would also have provided means for “*Streaming digital hypervideo including copious embedded hyperlinks is distributed upon a digital communications network form a hypervideo server, normally an Internet Service provider, to multitudinous client subscribers/users/viewers (client SUVs). . . .*” (see Rangan (the ABSTRACT)).

As per claim 4, Merriman in view of Srinivasan and Rangan shows the method of claim 1. (See the rejection of claim 1 supra).

Merriman lacks an explicit recitation of the elements and limitations of claim 4.

Srinivasan (col. 35, ll. 48-60; col. 35, ll. 7-20; col. 35, ll. 65-67; col. 36, ll. 1-25; col. 37, ll. 40-67; col. 38, ll. 1-25; col. 29, ll. 16-36; col. 30, ll. 40-54; col. 33, ll. 3-20; col.

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37, ll. 58-67; col. 38, ll. 1-25; the ABSTRACT; FIG. 11; FIG. 13; FIG. 14; FIG. 15; FIG. 16; FIG. 17; FIG. 18; col. 5, ll. 40-45; and col. 13, ll. 15-40) shows elements that suggest the elements and limitations of claim 4.

Srinivasan proposes transport modifications that would have applied to the method of Merriman. It would have been obvious at the time of the invention to a person of ordinary skill in the art to combine the teachings of Srinivasan with the disclosure of Merriman because such combination would have provided “*targeting of advertising over networks such as the Internet. . . . [and] gather information about recipients of the advertisement. . . .*” (see Merriman (col. 1, ll. 63-67; and col. 1, ll. 1-4)) and because such combination would also have provided means for “*enhancing the main video stream. . . .*” (see Srinivasan (col. 3, ll. 40-50)) and because such combination would also have provided means for “*Streaming digital hypervideo including copious embedded hyperlinks is distributed upon a digital communications network from a hypervideo server, normally an Internet Service provider, to multitudinous client subscribers/users/viewers (client SUVs). . . .*” (see Rangan (the ABSTRACT)).

As per claim 5, Merriman in view of Srinivasan and Rangan shows the method of claim 1. (See the rejection of claim 1 supra).

Merriman lacks an explicit recitation of the elements and limitations of claim 5.

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Srinivasan (col. 32, ll. 10-67; col. 34, ll. 23-45; col. 2, ll. 63-67; col. 3, ll. 1-10; col. 35, ll. 48-60; col. 35, ll. 7-20; col. 35, ll. 65-67; col. 36, ll. 1-25; col. 37, ll. 40-67; col. 38, ll. 1-25; col. 29, ll. 16-36; col. 30, ll. 40-54; col. 33, ll. 3-20; col. 37, ll. 58-67; col. 38, ll. 1-25; the ABSTRACT; FIG. 11; FIG. 13; FIG. 14; FIG. 15; FIG. 16; FIG. 17; FIG. 18; col. 5, ll. 40-45; and col. 13, ll. 15-40) shows elements that suggest the elements and limitations of claim 5.

Srinivasan proposes profile and identity modifications that would have applied to the method of Merriman. It would have been obvious at the time of the invention to a person of ordinary skill in the art to combine the teachings of Srinivasan with the disclosure of Merriman because such combination would have provided “*targeting of advertising over networks such as the Internet. . . . [and] gather information about recipients of the advertisement. . . .*” (see Merriman (col. 1, ll. 63-67; and col. 1, ll. 1-4)) and because such combination would also have provided means for “*enhancing the main video stream. . . .*” (see Srinivasan (col. 3, ll. 40-50)) and because such combination would also have provided means for “*Streaming digital hypervideo including copious embedded hyperlinks is distributed upon a digital communications network form a hypervideo server, normally an Internet Service provider, to multitudinous client subscribers/users/viewers (client SUVs). . . .*” (see Rangan (the ABSTRACT)).

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As per claim 6, Merriman in view of Srinivasan and Rangan shows the method of claim 1. (See the rejection of claim 1 supra).

Merriman lacks an explicit recitation of the elements and limitations of claim 6.

Srinivasan (col. 29, ll. 16-36; col. 30, ll. 40-54; col. 33, ll. 3-20; col. 37, ll. 58-67; col. 38, ll. 1-25; the ABSTRACT; FIG. 11; FIG. 13; FIG. 14; FIG. 15; FIG. 16; FIG. 17; FIG. 18; col. 5, ll. 40-45; and col. 13, ll. 15-40) shows elements that suggest the elements and limitations of claim 6.

Srinivasan proposes video advertising and target device modifications that would have applied to the method of Merriman. It would have been obvious at the time of the invention to a person of ordinary skill in the art to combine the teachings of Srinivasan with the disclosure of Merriman because such combination would have provided “targeting of advertising over networks such as the Internet. . . . [and] gather information about recipients of the advertisement. . . .” (see Merriman (col. 1, ll. 63-67; and col. 1, ll. 1-4)) and because such combination would also have provided means for “enhancing the main video stream. . . .” (see Srinivasan (col. 3, ll. 40-50)) and because such combination would also have provided means for “Streaming digital hypervideo including copious embedded hyperlinks is distributed upon a digital communications network form a hypervideo server, normally an Internet Service provider, to multitudinous client subscribers/users/viewers (client SUVs). . . .” (see Rangan (the ABSTRACT)).

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As per claim 7, Merriman in view of Srinivasan and Rangan shows the method of claim 1. (See the rejection of claim 1 supra).

Merriman lacks an explicit recitation of the elements and limitations of claim 7.

Srinivasan (col. 29, ll. 16-36; col. 30, ll. 40-54; col. 33, ll. 3-20; col. 37, ll. 58-67; col. 38, ll. 1-25; the ABSTRACT; FIG. 11; FIG. 13; FIG. 14; FIG. 15; FIG. 16; FIG. 17; FIG. 18; col. 5, ll. 40-45; and col. 13, ll. 15-40) shows elements that suggest the elements and limitations of claim 7.

Srinivasan proposes video advertising and target device modifications that would have applied to the method of Merriman. It would have been obvious at the time of the invention to a person of ordinary skill in the art to combine the teachings of Srinivasan with the disclosure of Merriman because such combination would have provided “targeting of advertising over networks such as the Internet. . . . [and] gather information about recipients of the advertisement. . . .” (see Merriman (col. 1, ll. 63-67; and col. 1, ll. 1-4)) and because such combination would also have provided means for “enhancing the main video stream. . . .” (see Srinivasan (col. 3, ll. 40-50)) and because such combination would also have provided means for “Streaming digital hypervideo including copious embedded hyperlinks is distributed upon a digital communications network form a hypervideo server, normally an Internet Service provider, to multitudinous client subscribers/users/viewers (client SUVs). . . .” (see Rangan (the ABSTRACT)).

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As per claim 8, Merriman in view of Srinivasan and Rangan shows the method of claim 1. (See the rejection of claim 1 supra).

Merriman lacks an explicit recitation of the elements and limitations of claim 8.

Srinivasan (col. 29, ll. 16-36; col. 30, ll. 40-54; col. 33, ll. 3-20; col. 37, ll. 58-67; col. 38, ll. 1-25; the ABSTRACT; FIG. 11; FIG. 13; FIG. 14; FIG. 15; FIG. 16; FIG. 17; FIG. 18; col. 5, ll. 40-45; and col. 13, ll. 15-40) shows elements that suggest the elements and limitations of claim 8.

Srinivasan proposes video advertising and target viewer modifications that would have applied to the method of Merriman. It would have been obvious at the time of the invention to a person of ordinary skill in the art to combine the teachings of Srinivasan with the disclosure of Merriman because such combination would have provided “targeting of advertising over networks such as the Internet. . . . [and] gather information about recipients of the advertisement. . . .” (see Merriman (col. 1, ll. 63-67; and col. 1, ll. 1-4)) and because such combination would also have provided means for “enhancing the main video stream. . . .” (see Srinivasan (col. 3, ll. 40-50)) and because such combination would also have provided means for “Streaming digital hypervideo including copious embedded hyperlinks is distributed upon a digital communications network form a hypervideo server, normally an Internet Service provider, to multitudinous client subscribers/users/viewers (client SUVs). . . .” (see Rangan (the ABSTRACT)).

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As per claim 10, Merriman in view of Srinivasan and Rangan shows the method of claim 1. (See the rejection of claim 1 supra).

Merriman lacks an explicit recitation of the elements and limitations of claim 10.

Srinivasan (col. 24, ll. 15-67; col. 25, ll. 1-67; col. 29, ll. 16-36; col. 30, ll. 40-54; col. 33, ll. 3-20; col. 37, ll. 58-67; col. 38, ll. 1-25; the ABSTRACT; FIG. 11; FIG. 13; FIG. 14; FIG. 15; FIG. 16; FIG. 17; FIG. 18; col. 5, ll. 40-45; and col. 13, ll. 15-40) shows elements that suggest the elements and limitations of claim 10.

Srinivasan proposes play and editing function modifications that would have applied to the method of Merriman. It would have been obvious at the time of the invention to a person of ordinary skill in the art to combine the teachings of Srinivasan with the disclosure of Merriman because such combination would have provided “targeting of advertising over networks such as the Internet. . . . [and] gather information about recipients of the advertisement. . . .” (see Merriman (col. 1, ll. 63-67; and col. 1, ll. 1-4)) and because such combination would also have provided means for “enhancing the main video stream. . . .” (see Srinivasan (col. 3, ll. 40-50)) and because such combination would also have provided means for “Streaming digital hypervideo including copious embedded hyperlinks is distributed upon a digital communications network form a hypervideo server, normally an Internet Service provider, to multitudinous client subscribers/users/viewers (client SUVs). . . .” (see Rangan (the ABSTRACT)).

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As per claim 11, Merriman in view of Srinivasan and Rangan shows the method of claim 1. (See the rejection of claim 1 supra).

Merriman lacks an explicit recitation of the elements and limitations of claim 11.

Srinivasan (col. 29, ll. 16-36; col. 30, ll. 40-54; col. 33, ll. 3-20; col. 37, ll. 58-67; col. 38, ll. 1-25; the ABSTRACT; FIG. 11; FIG. 13; FIG. 14; FIG. 15; FIG. 16; FIG. 17; FIG. 18; col. 5, ll. 40-45; and col. 13, ll. 15-40) shows elements that suggest the elements and limitations of claim 11.

Srinivasan proposes video advertising and target viewer modifications that would have applied to the method of Merriman. It would have been obvious at the time of the invention to a person of ordinary skill in the art to combine the teachings of Srinivasan with the disclosure of Merriman because such combination would have provided “targeting of advertising over networks such as the Internet. . . . [and] gather information about recipients of the advertisement. . . .” (see Merriman (col. 1, ll. 63-67; and col. 1, ll. 1-4)) and because such combination would also have provided means for “enhancing the main video stream. . . .” (see Srinivasan (col. 3, ll. 40-50)) and because such combination would also have provided means for “Streaming digital hypervideo including copious embedded hyperlinks is distributed upon a digital communications network form a hypervideo server, normally an Internet Service provider, to multitudinous client subscribers/users/viewers (client SUVs). . . .” (see Rangan (the ABSTRACT)).

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Claim 12 is rejected for substantially the same reasons as claim 1.

Claim 13 is rejected for substantially the same reasons as claim 2.

Claim 14 is rejected for substantially the same reasons as claim 3.

Claim 15 is rejected for substantially the same reasons as claim 4.

As per claim 16, Merriman in view of Srinivasan and Rangan shows the method of claim 12 (See the rejection of claim 12 supra).

Merriman (The ABSTRACT; col. 1, ll. 5-22; col. 1, ll. 28-45; col. 2, ll. 5-45; col. 3, ll. 4-67; col. 4, ll. 1-45; col. 5, ll. 63-67; and col. 6, ll. 1-12) shows elements that suggest the elements and limitations of claim 16 that “includes the interface.”

Merriman lacks an explicit recitation of: “inserting the selected video advertising into the video stream that transfers the selected video content to the target viewer.”

Srinivasan (col. 29, ll. 16-36; col. 30, ll. 40-54; col. 33, ll. 3-20; col. 37, ll. 58-67; col. 38, ll. 1-25; the ABSTRACT; FIG. 11; FIG. 13; FIG. 14; FIG. 15; FIG. 16; FIG. 17; FIG. 18; col. 5, ll. 40-45; and col. 13, ll. 15-40) shows elements that suggest “inserting the selected video advertising into the video stream that transfers the selected video content to the target viewer.”

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Srinivasan proposes video advertising insertion modifications that would have applied to the method of Merriman. It would have been obvious at the time of the invention to a person of ordinary skill in the art to combine the teachings of Srinivasan with the disclosure of Merriman because such combination would have provided *“targeting of advertising over networks such as the Internet. . . . [and] gather information about recipients of the advertisement. . . .”* (see Merriman (col. 1, ll. 63-67; and col. 1, ll. 1-4)) and because such combination would also have provided means for *“enhancing the main video stream. . . .”* (see Srinivasan (col. 3, ll. 40-50)) and because such combination would also have provided means for *“Streaming digital hypervideo including copious embedded hyperlinks is distributed upon a digital communications network form a hypervideo server, normally an Internet Service provider, to multitudinous client subscribers/users/viewers (client SUVs). . . .”* (see Rangan (the ABSTRACT)).

Claim 17 is rejected for substantially the same reasons as claim 7.

Claim 18 is rejected for substantially the same reasons as claim 8.

Claim 20 is rejected for substantially the same reasons as claim 10.

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Claim 21 is rejected for substantially the same reasons as claim 11.

Claim 22 is rejected for substantially the same reasons as claim 1.

Claim 23 is rejected for substantially the same reasons as claim 2.

Claim 25 is rejected for substantially the same reasons as claim 10.

As per claim 26, Merriman in view of Srinivasan and Rangan shows the method of claim 22. (See the rejection of claim 22 supra).

Merriman lacks an explicit recitation of the elements and limitations of claim 26.

Srinivasan (col. 29, ll. 16-36; col. 30, ll. 40-54; col. 33, ll. 3-20; col. 37, ll. 58-67; col. 38, ll. 1-25; the ABSTRACT; FIG. 11; FIG. 13; FIG. 14; FIG. 15; FIG. 16; FIG. 17; FIG. 18; col. 5, ll. 40-45; and col. 13, ll. 15-40) shows elements that suggest the elements and limitations of claim 26.

Srinivasan proposes video advertising and target viewer modifications that would have applied to the method of Merriman. It would have been obvious at the time of the invention to a person of ordinary skill in the art to combine the teachings of Srinivasan with the disclosure of Merriman because such combination would have provided “targeting of advertising over networks such as the Internet. . . . [and] gather information

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about recipients of the advertisement. . . .” (see Merriman (col. 1, ll. 63-67; and col. 1, ll. 1-4)) and because such combination would also have provided means for “enhancing the main video stream. . . .” (see Srinivasan (col. 3, ll. 40-50)) and because such combination would also have provided means for “Streaming digital hypervideo including copious embedded hyperlinks is distributed upon a digital communications network form a hypervideo server, normally an Internet Service provider, to multitudinous client subscribers/users/viewers (client SUVs). . . .” (see Rangan (the ABSTRACT)).

Claim 27 is rejected for substantially the same reasons as claim 5.

RESPONSE TO ARGUMENTS

7. Applicant's arguments (Amendment C, paper#11, filed 08/14/2003) concerning the rejections/objections in the prior Office Action have been considered but are not persuasive for the following reasons:

Applicant's arguments/remarks (Amendment C, paper#11, pp. 8-9 concerning independent claims 1, 12 & 22) allege that “Neither Merriman nor Srinivasan teach or suggest disabling a fast-forward capability when the selected video advertising id displayed.” This is not the case.

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Rangan (col. 13, ll. 4-15; and col. 26, ll. 26, ll. 60) shows elements that suggest “disabling fast-forward capability when the selected video advertising is displayed.”

It is well settled in the law that the test for obviousness is not whether the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); furthermore,

It is well settled in the law that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); in this case, as stated above, Rangan (col. 13, ll. 4-15; and col. 26, ll. 26, ll. 60) shows elements that would have suggested to a person of ordinary skill in the art at the time of the invention “disabling fast-forward capability when the selected video advertising is displayed.”

In response to Applicant’s arguments/remarks (Amendment C, paper#11, p. 9) which allege that “Claims 2-8, 10-11, 13-18, 20-21, 23, and 25-27 depend from claims 1, 12, and 22, and are patentable for at least the reasons given above. . . .” amount to

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general allegations that said claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

CONCLUSION

8. Any response to this action should be mailed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh Floor Receptionist

Crystal Park V

2451 Crystal Drive

Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

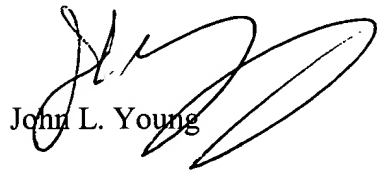
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

2451 Crystal Drive

Arlington, Virginia.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read "John L. Young". The signature is stylized with a large, sweeping loop at the end.

Patent Examiner

December 8, 2003